



36 DAE

PATENT
ATTORNEY DOCKET NO. 056100-5021-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:)
)
Andrew Z. FIRE *et al.*)
)
U.S. Patent No.: 6,506,559)
)
Application No.: 09/215,257)
)
Filed: December 18, 1998)
Issued: January 14, 2003)
)
For: GENETIC INHIBITION BY)
DOUBLE STRANDED RNA)

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OFFICE OF PETITIONS

Mail Stop Petition
U.S. Patent and Trademark Office
Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA 22202

Sir:

PETITION FOR RECONSIDERATION

Applicants hereby request reconsideration of the dismissal of the Petition to Reprint the Front Page of the Letters Patent pursuant to 37 C.F.R. § 1.182 directed to the above-identified patent, U.S. Patent No. 6,506,559 as indicated in the Decision issued by the Office of Petitions dated July 18, 2003 (copy attached).

In the Decision, the Office of Petitions dismissed the petition for failure to return the original Letters Patent. In fact this has already been done. Although we detected the error in assignee designation on the face of the patent immediately upon its issuance, Tuesday, January 14, 2003, we purposefully waited for receipt of the Letters Patent to file the Petition on January 22, 2003. As evidenced from the attachments listed on page 3 of the Petition to Reprint the Front Page of the Letters Patent filed on January 22, 2003 (copy attached), and from the stamped proof of receipt post card (copy attached), the Letters Patent were returned as part of the January 22, 2003 submission.

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Accordingly, reconsideration of the Petition to Reprint the Front Page of the Letters of Patent is respectfully requested.

If any additional fees are required over and above those already paid with the Petition to Reprint the Front Page of the Letters of Patent filed on January 22, 2003, the Commissioner is hereby authorized to charge such fees to Deposit Account 50-0310.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

By: Elizabeth C. Weimar
Elizabeth C. Weimar
Reg. No. 44,478

Dated: August 11, 2003

MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
202-739-3000

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Attorney Docket No. 056100-5021-01
U.S. Patent No. 6,506,559

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:

Andrew Z. FIRE *et al.*

U.S. Patent No.: 6,506,559

Application No.: 09/215,257

Filed: December 18, 1998

Issued: January 14, 2003

For: GENETIC INHIBITION BY
DOUBLE STRANDED RNA

PETITION UNDER 37 C.F.R. § 1.182
TO REPRINT THE FRONT PAGE
OF THE LETTERS PATENT

** Hand-Carry To Office Of Petitions
Crystal Plaza 4, Room 3-C23 **

Office of Petitions

Assistant Commissioner for Patents
Washington, D.C. 20231

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This is a Petition under 37 C.F.R. § 1.182 to request that the front page of the attached original Letters Patent be corrected and reprinted to include the correct names of the assignees. Accompanying this petition is a second petition requesting that the rules under 37 CFR §3.81(a) be waived to permit the correct names of the assignees of the above-mentioned patent to be provided after issuance.

On October 22, 2002, Applicant's agent submitted two copies of Issue Fee Transmittal Form PTOL-85 noting the sole assignee as "Carnegie Institute of Washington." This assignee designation was erroneous in two respects:

- (1) A second assignment to "The University of Massachusetts" was recorded on March 19, 1999, at Reel/Frame 009825/0207 (copies of the Notice of Recordation and assignment documents are attached hereto); and
- (2) "Carnegie Institute of Washington" contains an inadvertent error in that the word "Institute" should actually be "Institution" (see copies of Notice of Recordation and assignment

attached hereto). Thus, the correct name of the first assignee should be "Carnegie Institution of Washington," and "The University of Massachusetts" should be included on the face of the patent as the second assignee. As explained in the attached petition under 37 CFR §1.183, the error was inadvertent and due to high public interest, the Office should reprint the first page, particularly in view of patentee's promptness in seeking the requested relief.

According to 37 CFR §1.182, all situations not specifically provided for in the regulations will be decided in accordance with the merits of each situation by or under the authority of the Commissioner. The Commissioner therefore has the authority to approve reprinting of the first page of the Letters Patent. While Applicant is aware that the original Letters Patent is reprinted only under very rare circumstances, as explained in the attached Petition under 37 CFR §1.183, justice requires that the correct assignees be named on the face of the patent in the present case.

The above-mentioned patent covers one of the most important inventions of the year, an invention that is jointly owned by Carnegie Institution of Washington and The University of Massachusetts. The importance of the invention is emphasized by several scientific articles submitted herewith and discussed in the accompanying petition under 37 CFR §1.183. Given the importance of the invention and the number of readers that will no doubt request a copy of the patent, it is only fair that both of the owners of this important invention are shown on the face of the patent. Listing the second assignee in a certificate of correction rather than on the face of the patent would not serve justice adequately, since the face of the patent would be viewed by potential readers much more frequently than a certificate attached to the patent. Failure to correct the face of the patent to reflect the names of both assignees would rob the second

assignee of its due recognition as a co-owner of the invention, an injustice that should not prevail solely because the Applicant's agent made an inadvertent error in completing the PTOL-85 form.

The \$130.00 petition fee required by 37 C.F.R. § 1.17(h) is being submitted with this Petition. The Commissioner is hereby authorized to charge any additional fees, or credit any overpayment, to Deposit Account 50-0310.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP



Bonnie Weiss McLeod, Ph.D.

Reg. No. 43,255

January 22, 2003

CUSTOMER NO.: 009629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Telephone: 202-739-3000
Facsimile: 202-739-3001

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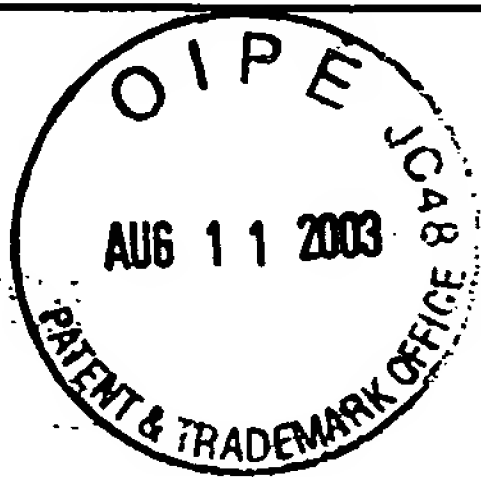
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Attachments:

- Petition under 37 CFR §1.183 to Waive the Rules under 37 CFR §3.81(a)
- Notice of Assignment recordation and assignment for University of Massachusetts
- Notice of Assignment recordation and assignment for Carnegie Inst. of Washington
- Letters Patent
- Journal article: Science, Dec. 2002, Vol. 298, pages 2296-97
- Journal article: excerpt from The Wall Street Journal, Tuesday, Aug. 6, 2002
- Journal article: Genetic Engineering News, Dec. 2002, Vol. 22(21), pages 1, 3, 70 & 80
- Meeting agenda, Applications of RNA Interference, Feb. 10-11, San Diego, CA



UNITED STATES PATENT AND TRADEMARK OFFICE



COMMISSIONER FOR PATENTS
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Paper No. 35

MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE, NW
WASHINGTON, DC 20004

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JUL 18 2003

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ON PETITIONS

In re Patent No.
6,506,559
Issue Date: January 14, 2003
Application No. 09/215,257
Filing Date: December 18, 1998
Attorney Docket No. PM256628

This is a decision on the petition under 37 CFR 1.183 filed January 22, 2003, to waive the requirements of 37 CFR 3.81 and accept the correction of the assignee data on the front page of the above-identified patent. This is also a decision on the petition under 37 CFR 1.182 to reprint the assignees name on the front page of the Letter of Patent.

The petition under 37 CFR 1.183 to correct the assignee data is **GRANTED**.

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The petition under 37 CFR 1.182 to reprint the front page of the Letters of Patent is **DISMISSED**.

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TREATMENT UNDER 37 CFR 1.183

OFFICE OF PETITIONS

Petitioner is advised that it is the practice of the Patent and Trademark Office (PTO) to issue a certificate of correction to correct an error on the part of an applicant in those cases where the assignee or attorney data is incorrect or was inadvertently not provided at the time of payment of the issue fee or the inventor's name is misspelled or otherwise incorrect. Note 37 CFR 1.323 and MPEP 1481, which states:

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Commissioner may, upon payment of the required fee issue a Certificate of Correction, of the correction does not involve such changes in the patent as would constitute new matter or would require reexamination.

Further, a correction of assignee data after issuance of the patent can only be made if the assignment was recorded before the issue date of the patent. Assignments to The Carnegie Institution of Washington and the University of Massachusetts were recorded on March 19, 1999, prior to the January 14, 2003, issue date of the patent. It is possible, therefore, to correct the assignee data on the patent; the petition under 37 CFR 1.183 is granted.

Although the correction can be accomplished by a Certificate of Correction, petitioner has requested that the front page of the Letters of Patent be reprinted.

TREATMENT UNDER 37 CFR 1.182

Petitioner has requested that the front page of the Letters of Patent be reprinted because of extenuating circumstances relative to the public nature of the invention and out of fairness to the assignees. The PTO will reprint the front page of the Letter of Patent if the following conditions are met:

1. submission of the petition fee under 37 CFR 1.182.
2. payment of the \$130.00 petition fee.
3. payment of a \$100.00 fee to place a certificate of correction in the PTO archives.
4. return of the original Letters of Patent.

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By SDW Date 7-22-03

The petition under 37 CFR 1.182 to reprint the front page of the Letter of Patent cannot be granted at this time because petitioner did not return the original Letters of Patent. Although the petition under 37 CFR 1.183 has been granted, no further action will be taken relative to the issuance of a Certificate of Correction until petitioner provides a response to this decision. An appropriate response would be either a renewed petition under 37 CFR 1.182 accompanied by the Letter of Patent or a letter indicating that petitioner no longer seeks the reprinting of the Letter of Patent and that the Certificate of Correction will suffice.

Deposit account 50-0310 will be assessed \$130.00 for the petition under 37 CFR 1.183 and \$130.00 for the petition under 37 CFR 1.182.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 PO Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 308-6916
 Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
 2201 South Clark Place
 Arlington, Virginia

Telephone inquiries should be directed to the undersigned (703) 305-0010.



Kenya A. McLaughlin
Petitions Attorney
Office of Petitions



PLEASE STAMP AND RETURN TO SHOW RECEIPT OF:

Patent Application of: Andrew Z. *FIRE*, et al.
U.S. Patent No.: 6,506,559
Application No.: 09/215,257
Filed: December 18, 1998
Issued: January 14, 2003
For: GENETIC INHIBITION BY DOUBLE-STRANDED RNA

HAND CARRY TO:
OFFICE OF PETITIONS
CRYSTAL PLAZA 4, ROOM 3—C23

ATTN: BOX PATENT APPLICATION

1. Petition Under 37 C.F.R. § 1.182 To Reprint The Front Page of
THE LETTERS PATENT
2. Petition under 37 CFR §1.183 to Waive the Rules under 37 CFR §3.81(a)
3. Notice of Assignment recordation and assignment for University of Massachusetts
4. Notice of Assignment recordation and assignment for Carnegie Inst. of Washington
5. Letters Patent
6. Journal article: Science, Dec. 2002, Vol. 298, pages 2296-97
7. Journal article: excerpt from The Wall Street Journal, Tuesday, Aug. 6, 2002
8. Journal article: Genetic Engineering News, Dec. 2002, Vol. 22(21), pages 1, 3, 70 & 80
9. Meeting agenda, Applications of RNA Interference, Feb. 10-11, San Diego, CA
10. Authorization to deduct from Deposit Account No. 50-0310 the Petition Fees of -----\$260.00
and the fee for filing the Correction in the Archives-----\$100.00
\$360.00

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JAN 22 2003

OFFICE OF PETITIONS

Date: January 22, 2003
Attorney Docket No.: 056100-5021-01
BWM:vwf

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